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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,137	07/11/2001	Christopher M. Tobin	50P4390	2542

530 7590 12/19/2006  
LERNER, DAVID, LITTENBERG,  
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WESTFIELD, NJ 07090

EXAMINER
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VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/903,137

Applicant(s)

TOBIN ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in reference to response received 18 September 2006. Claims 1 – 24 are pending for examination.

### ***Response to Arguments***

Applicant's arguments and response are for amended claims. They are responded to in response to pending claims below.

### ***Claim Objections***

Claims 1 – 24 are objected to because of the following informalities:

Independent claims 1, 11 and 18 recite the limitation "copy of the particular content is received through the electronic content distribution system. Since the electronic content is stored in the electronic content distribution system", examiner reads the limitation as "copy of the particular content is received from the electronic content distribution system. Since the electronic content is stored in the electronic content distribution system". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 10 and 18 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are for example:

applicant recites the limitation user providing an identifier for an optical storage medium to get particularized credit, however, applicant further limits identifier to be digital fingerprint. Applicant has not positively claimed how the user extracts the digital fingerprint, converts it to human recognizable format and provide the digital content to the server.

Applicant has claimed the limitation identifier indicating that the given identifier indicates that the given read only optical storage medium contains a particular content. Applicant has not positively claimed how the identifier is created for optical storage mediums with digital contents created by the user. Also, it is not clear how this user created optical disk is identified by the system to be containing particular content.

Claims 11 – 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are for example:

applicant recites the limitation means for user providing an identifier for an optical storage medium to get particularized credit, however, applicant further limits identifier to be digital fingerprint. Applicant has not positively claimed means adapted for the user to extract the digital fingerprint, converts it to human recognizable format and provide the digital content to the server.

Applicant has claimed the limitation means for identifying that the given identifier indicates that the given read only optical storage medium contains a particular content. Applicant has not positively claimed means adapted identifying the content when the user has created the optical storage mediums with digital contents. Also, it is not clear how this user created optical disk is identified by the system to be containing particular content.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 9, 11 – 16 and 18 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle US Patent 5,400,402.

Regarding claims 1, 11 and 18, as best understood by examiner, Garfinkle teaches method, apparatus and system for providing particularized credit to a user in an electronic content distribution system (e.g. limiting number of use) that implements a network (fiber optic, publically switched, telephone link, a satellite wireless link or a cable television link). Garfinkle teaches:

receiving an identifier for a given particular digital content through a network.

providing a particular content to the user (number of times data content can be played):

redemption of credit by the user (order may be placed using a keyed-in code).

A copy of the particular content is received through the electronic content distribution system (The link 12 serves to down-load, at high speed, a video program to a specific customer address from which an order has been placed from a remote customer site 10).

Regarding claims 4, 12 and 19, as best understood by examiner, Garfinkle teaches capability wherein identifier is a digital fingerprint that identifies the given read only optical storage medium (customer orders using the movie number instead of movie name).

Regarding claims 5, 13 and 20, Garfinkle teaches capability wherein read only optical storage medium is a compact disc.

Regarding claim 6, Garfinkle teaches capability wherein network is an Internet.

Regarding claims 2, 7, 14 and 21, Garfinkle teaches capability wherein particular content includes a musical work (music video).

Regarding claims 3, 8, 15 and 22, Garfinkle teaches capability wherein particular content includes musical compilation comprising a plurality of musical works (movie with plurality of musical works, e.g. Sound of Music).

Regarding claims 9, 16 and 23, Garfinkle teaches capability wherein electronic content distribution system downloads the musical work to the user pursuant to a transaction including particular credit by the user.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle US Patent 5,400,402 in view of Rhoades US Patent 5,051,822.

Regarding claims 10, 17 and 24, Garfinkle does not explicitly teaches to stream digital content. However, Rhoades teaches idea of streaming digital content.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Garfinkle as taught by Rhoades to minimize copyright violation by maintaining copies of the digital content at the server only.

Garfinkle in view of Rhoades teach capability wherein electronic content distribution system streams musical work to the user pursuant to a transaction including particular credit by the user (e.g. video on demand).

### ***Conclusion***

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

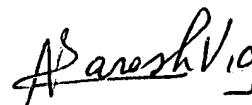


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629

December 5, 2006